REMARKS

Reconsideration of this Application is respectfully requested. Claims 15-21, 23-29, 32-36 and 38-52 are pending in the application, with claims 15, 23, 28, and 34 being the independent claims.

Rejections Under 35 U.S.C. § 112

Claims 23 and 28 stand rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirement. In particular, the Examiner states that the claims contain subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner states that the language of claim 23, which recites "except that the personal identification device is configured to send the digital certificate to an enrollment party during future enrollment" is not supported in the specification. Similarly, the Examiner states that the language of claim 28, which recites "the processor configured to disable functionality of the memory and the processor associated with a party other than an enrollment party" is also not supported in the specification. The Examiner states that the specification only suggests "all functionality within the personal identification device is disabled, such that it is in a wait state for future enrollment" as recited paragraph [0081].

The Applicants respectfully disagree. Paragraphs [0082] and [0083] of the specification describe a process for enrolling personal identity credentials into the personal identification device. In other words, paragraphs [0082] and [0083] describe functionality of the personal identification device that is left enabled after the end of the pre-enrollment process referred to in paragraph [0081] (e.g., when the personal identification device is in a wait state for future enrollment). Thus, personal identity credentials can be enrolled into personal identification device during the enrollment process of paragraphs [0082] and [0083] after the pre-enrollment process of paragraph [0081].

Independent claim 23, which recites "sending the digital certificate to the personal identification device such that functionality of the personal identification device is disabled except that the personal identification device is configured to send the digital certificate to an enrollment party during future enrollment," is supported in the specification at paragraph [0081], which recites "receiv[ing] the personal identification device's digital certificate" at an enrollment authority. The personal identification device has functionality associated with sending the digital certificate enabled for the enrollment authority to receive the digital certificate. Accordingly, the Applicants request that the rejection of independent claim 23 under the first paragraph of 35 U.S.C. § 112 be withdrawn.

Independent claim 28, which recites a "processor configured to disable functionality of the memory and the processor associated with a party other than an enrollment party," is also supported in the specification. As discussed above, the processor has functionality associated with the enrollment authority enabled (e.g., when the personal identification device is in its wait state for future enrollment) so it is possible to enroll personal identity credentials during the enrollment process as described in paragraphs [0082] and [0083]. Accordingly, the Applicants request that the rejection of independent claim 23 under the first paragraph of 35 U.S.C. § 112 be withdrawn.

The Claims are Patentable Over Russo in view of Prokoski

Claims 15-21, 23-29, 32-36 and 38-52 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2003/0115475 to Russo et al. ("*Russo*") in view of U.S. Patent No. 6,850,147 to Prokoski et al. ("*Prokoski*"). This rejection is traversed for the reasons below.

All of *Prokoski*'s disclosure identified by the Examiner (col. 5, lines 30-55; col. 6 lines 7-27; and col. 7, lines 3-23) is directed to post-enrollment events and not pre-enrollment events. For example, *Prokoski* discloses a personal biometric key that can be used to unlock or access any device that has a biocompatible receiver during post-enrollment use. (See col. 6, lines 19-25).

Unlike independent claim 15, which recites "disabling functionality within the personal identification device except that the personal identification device is in a wait state associated with future enrollment," *Russo* in view of *Prokoski* is entirely silent. As the Examiner states, *Russo* does not explicitly teach the above recited claim language. *Prokoski*, as described above, merely discloses post-enrollment use. Moreover, *Prokoski* fails to disclose or suggest any disabling of functionality within the personal identification device or a wait state associated with future enrollment. Accordingly, the Applicants request that the rejection of independent claim 15 and its dependent claims 16-21, 38-40 and 50 under 35 U.S.C. § 103(a) be withdrawn.

Unlike independent claim 23, which recites "producing a digital certificate ... before enrollment of biometric data and sending the digital certificate to the personal identification device such that functionality of the personal identification device is disabled except that the personal identification device is configured to send the digital certificate to an enrollment party during future enrollment," *Russo* in view of *Prokoski* is entirely silent. As the Examiner states, *Russo* does not explicitly teach the above recited claim language. *Prokoski*, as described above, is directed to post-enrollment use. Moreover, *Prokoski* does not disclose or suggest a personal identification device that has its functionality disabled except that functionality to send the digital certificate to an enrollment party during future enrollment is not disabled. Accordingly, the Applicants request that the rejection of independent claim 23 and its dependent claims 24-27, 41-43 and 51 under 35 U.S.C. § 103(a) be withdrawn.

Unlike independent claim 28, which recites a "processor configured to disable functionality of the memory and the processor associated with a party other than an enrollment party," *Russo* in view of *Prokoski* is entirely silent. As the Examiner states, *Russo* does not explicitly teach the above recited claim language. *Prokoski* merely allowing the user to enroll their own keys. (See col. 7, lines 7-9). *Prokoski* is entirely silent with respect to a processor having functionality associated with an enrollment party enabled and having functionality not associated with the enrollment authority disabled. Accordingly, the Applicants request that the rejection of independent claim 28 and its dependent claims 29, 32-33 and 44-46 under 35 U.S.C. § 103(a) be withdrawn.

Unlike independent claim 34, which recites "disabling functionality within the personal identification device except for functionality associated with future enrollment," *Russo* in view of *Anthony* is entirely silent for at least the reasons discussed above with respect to independent claim 15. Accordingly, the Applicants request that the rejection of independent claim 34 and its dependent claims 35-36, 47-49 and 52 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

All of the stated grounds of rejection have been properly overcome. The Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. The Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that further personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.
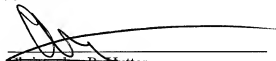
Prompt and favorable consideration of this application is respectfully requested.

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